



THW

Docket No. 1293.1210

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Jang-hoon YOO, et al.

Serial No. 09/899,501

Group Art Unit: 2656

Confirmation No. 9910

Filed: July 6, 2001

Examiner: Nabil Z. Hindi

For: COMPATIBLE OPTICAL PICKUP DEVICE USING A SINGLE LIGHT SOURCE

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

Sir:

This is responsive to the Office Action mailed December 13, 2005, having a shortened period for response set to expire on January 13, 2006, the following remarks are provided.

I. Provisional Election of Claims

Applicants provisionally elect Group I, claims 1-15, 36, and 37.

II. Applicants Traverse the Requirement

On pages 2-3 of the Office Action, the Examiner asserts that Groups I through III are distinct inventions related as subcombinations usable together in a single combination. By way of review, in order to maintain a prima facie case for restriction based upon subcombinations, the Examiner needs to provide evidence that the subcombinations have separate utility, and are "usable together in a single combination." MPEP 806.05(d). By way of example, in *Ex parte Healy*, 1898 C.D. 157, 84 O.G. 1281 (Comm'r Pat. 1898), a clamp for a handle bar stem and a specifically different clamp for a seat post, both usable together on a bicycle, were separately claimed and found to be distinct. As such, in order to substantiate such a restriction requirement based upon subcombinations useable together, there needs to be evidence of record that the different subcombinations, as claimed, are actually used together in a single combination.

In the Office Action, the Examiner asserts that the Group I, Group II, and Group III claims have separate utility based upon their separate sub-classifications within class 369, but does not provide evidence that such subcombinations are present in a same optical pickup device. As such, there is insufficient evidence of a single combination in which the subcombinations can be used together as is required to maintain the restriction requirement.

Moreover, even assuming *arguendo* that the separate sub-classifications are proper, the Examiner has not provided evidence that the Examiner will experience an undue burden in searching and examining the invention set forth in Groups I through III, and has not presented evidence as to the changed circumstance which warrants a restriction after the first action on the merits. As such, it is respectfully submitted that the Examiner has not presented sufficient evidence of a burden on the Examiner in examining Groups I through III which is out of proportion with the delay and expense visited on the applicants in filing divisional applications to timely protect the invention recited in Groups II and III so as to require restriction between these Groups. Therefore, it is respectfully requested that the Examiner reconsider and withdraw the requirement.

III. Conclusion

Upon review of references involved in this field of technology, and when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial election requirement, all of the pending claims should be examined in the subject application. In view of the foregoing arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition for allowance.

Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

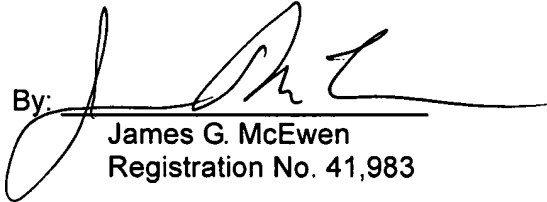
SERIAL NO. 09/899,501

DOCKET NO. 1293.1210

If there are any additional fees associated with the filing of this Response, please charge the same to our Deposit Account No. 503333.

Respectfully submitted,

STEIN, MCEWEN & BUI LLP

By: 
James G. McEwen
Registration No. 41,983

1400 Eye Street, NW
Suite 300
Washington, D.C. 20005
Telephone: (202) 216-9505
Facsimile: (202) 216-9510

Date: JAN 12, 2006